

Remarks

I. INTRODUCTION

Claims 11 to 22 are currently pending in the present application. Claim 14 has been amended to address an informality. Reconsideration of the present application is requested based on the following discussion.

II. REJECTION OF CLAIMS 11, 13, 14 and 19-22 UNDER 35 U.S.C. § 103(a)

Claims 11, 13, 14 and 19-22 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,224,011 to Yalla et al. (the “Yalla patent”) in view of U.S. Patent No. 4,429,340 to Howell (the “Howell patent”). It is respectfully submitted that none of claims 11, 13, 14 and 19-22 are rendered obvious by the combination of the Yalla and Howell patents, for at least the following reasons.

To sustain an obviousness rejection, the Patent Office has the burden of showing that there is some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, this teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In addition, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As noted in the previous responsive amendment, claim 19 recites, inter alia, the following:

wherein the LCD elements include a different respective LCD element for each of the tripping parameters to be adjusted.

In the Final Office Action, the Examiner acknowledges that the Yalla patent does not disclose this feature, but it is asserted that the Howell patent cures this deficiency of the Yalla patent. In particular, the Final Office Action states that “Howell discloses the circuit breaker having plural displays (elements 64 and 66 in Fig. 1) visually displaying different tripping parameters of the system . . . [t]herefore it would have been obvious to one of ordinary skill at the time the invention was made to have modified the Yalla solution by adding LCD displays, one for each tripping parameter, according to Howell.”

It is respectfully submitted that this statement is incorrect in that the bargraph displays referred to (elements 64 and 66) display a current conducted from a switch or a time remaining (or elapsed) following detection of an overcurrent, **but do not in any way display or pertain to the triggering parameters**. In contrast, in the Howell patent, the setting of parameters occurs using elements 30 and 56; these set parameters are not displayed with the aid of an LCD element.

Moreover, the Howell patent discloses using the same bargraph display 66 for displaying two parameters – the time remaining or elapsed in the “long time trip mode” and

in the “short time trip mode” – and therefore teaches away from using a separate display element for each individual set parameter.

For at least these reasons, it is submitted that the one of skill in the art would not be motivated to combine Yalla the Howell patents to arrive at the claimed subject matter. Furthermore, even if these references were combined (which they should not be) the combination would still fail to disclose or suggest each of the elements of claim 19, which is, therefore, not rendered obvious by the combination of the Yalla and Howell patents.

Claims 11, 13 and 14 depend from claim 19. Accordingly, for at least the same reasons as discussed above in connection with claim 19, the combination of the Yalla and Howell patents does not render obvious claims 11, 13 and 14.

Independent claim 21 recites features analogous to those discussed above with respect to claim 19, the combination of the Yalla and Howell patents does not render obvious claim 21 or its dependent claim 22.

In view of the foregoing, the rejection of claims 11, 13, 14 and 19-22 should be withdrawn.

III. REJECTION OF CLAIM 12 UNDER 35 U.S.C. § 103

Claim 12 stands rejected under 35 U.S.C. § 103 as being obvious over the Yalla patent in view of the Howell patent and further in view of U.S. Patent No. 5,852,543 to Dvorak et al. (the “Dvorak patent”). It is respectfully submitted that claim 12 is not obvious over the references relied upon, for at least the following reasons.

Claim 12 depends from claim 19. Accordingly, the arguments presented above in connection with claim 19 and the Yalla and Howell patents apply equally to claim 12. The Dvorak patent does not cure the deficiencies of the Yalla and Howell references discussed above. For at least this reason, the rejection of claim 12 should be withdrawn.

IV. REJECTION OF CLAIMS 15 AND 16 UNDER 35 U.S.C. § 103

Claims 15 and 16 stand rejected under 35 U.S.C. § 103 as being obvious over the Yalla patent and Howell patents in view of U.S. Patent No. 5,038,246 to Durivage, III (the “Durivage patent”). It is respectfully submitted that none of claims 15 and 16 are rendered obvious by the references relied upon, for at least the following reasons.

Claims 15 and 16 depend from claim 19. Thus, the arguments presented above in connection with claim 19 and the Yalla and Howell patents apply equally to claims 15 and 16. The Durivage patent does not cure the deficiencies of the Yalla and Howell patents discussed above. For at least this reason, the rejection of claims 15 and 16 should be withdrawn.

V. REJECTION OF CLAIM 17 UNDER 35 U.S.C. § 103

Claim 17 stands rejected under 35 U.S.C. § 103 as being obvious over the Yalla and Howell patents, in view of the Durivage patent, and in further view of *In re Stevens*. It is respectfully submitted that claim 17 is not obvious over the Yalla and Howell patents, in view of the Durivage patent and in further view of *In re Stevens*, for at least the following reasons.

Claim 17 depends from claim 19. Thus, the arguments presented above in connection with claim 19 apply equally to claim 17. The Durivage patent and *In re Stevens* do not cure the deficiencies of the Yalla and Howell patents. For at least this reason, the rejection of claim 17 should be withdrawn.

VI. REJECTION OF CLAIM 18 UNDER 35 U.S.C. § 103

Claim 18 stands rejected under 35 U.S.C. § 103 as being obvious over the Yalla and Howell patents in view of an LCD element from Kent. It is respectfully submitted that claim 18 is not obvious over the Yalla and Howell patents and the LCD element from Kent, for at least the following reasons.

Claim 18 depends from claim 19. Thus the arguments presented above in connection with claim 19 and the Yalla and Howell patents apply equally to claim 18. The LCD from Kent does not cure the deficiencies of the Yalla and Howell patents. For at least these reasons, the rejection of claim 18 should be withdrawn.

VII. CONCLUSION

In light of the foregoing, Applicants respectfully submit that all pending claims 11-22 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,



Dated: 25 Dec 1994

By: 

Richard L. Mayer
(Reg. No. 22,490)

KENYON & KENYON
One Broadway
New York, New York 10004
(212) 425-7200
Customer No. 26646